

REMARKS

Claims 1-11 are pending in this application. Claims 1-11 stand rejected and claim 8 is objected to. By this Amendment, claim 8 has been amended. The amendments made to claim 8 do not alter the scope of this claims, nor has this amendment been made to define over the prior art. Rather, the amendment to claim 8 has been made for cosmetic reasons to improve the form thereof. In light of the amendments and remarks set forth below, Applicant respectfully submits that each of the pending claims is in immediate condition for allowance.

Claim 8 was objected to due to “transmitted/received” as being indefinite. Applicant has amended claim 8 to recite “transmitted and received”. As such, Applicant respectfully requests that the objection to claim 8 be withdrawn.

Claims 1-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,493,547 (“Raith”). Applicant respectfully requests reconsideration and withdrawal of this rejection.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine references to arrive at the claimed subject matter. The prior art references must also teach or suggest all the limitations of the claim in question. See, M.P.E.P. § 706.02(j). A reference can only be used for what it clearly discloses or suggests. See, In re Hummer, 113 U.S.P.Q. 66 (C.C.P.A. 1957); In re Stencel, 4 U.S.P.Q.2d

1071, 1073 (Fed. Cir. 1987). Here, the references, whether taken individually or in combination, do not disclose or suggest the invention claimed by the Applicant.

Among the limitations of independent claims 1 and 11 not present in Raith is counting means for counting the form package data before transmission.

The Office Action asserts that Raith “teaches a terminal may display anticipated charges based # of data packets per col. 11, lns. 23-44 or counting means.” Office Action at 3. Applicant disagrees with this interpretation of Raith. In Raith, a terminal extrapolates current cumulative usage from actual cumulative usage. The actual cumulative usage is received by the terminal in a message. Raith at col. 11, lns. 23-44 merely discloses the various ways cumulative usage may be displayed. Further, Raith discloses that remaining time can be displayed by converting the time used to time remaining. However, there is no disclosure of counting means for counting the form packet data before transmission. Raith only keeps track of actual usage and extrapolated usage. There is no provision in Raith for counting packet data prior to transmission and displaying a calculated charge for the pre-transmitted packet. In Raith, the extrapolation is performed on data transmitted to the terminal.

The Office Action admits that Raith does not expressly call for counting means or that the communication charges calculated before the packet is transmitted but teaches that the anticipated charged based upon the number of data packets used is displayed. The Office Action then asserts that it would have been obvious for one of ordinary skill in the art at the time of the invention that displaying the

anticipated charges based upon the number of data packets used requires a counting means in order for the invention to work and that anticipated charges performed the same function as displaying the charge before the package is sent. However, as discussed above, Raith fails to disclose counting means for counting the form packet before data transmission as well as failing to disclose displaying anticipated charges.

The Office Action asserts that the charge rate information, which is transmitted to a terminal, would render Applicant's recited counting means for counting form packet data and displaying a communication charge calculated on the basis of accounting obvious. However, Raith fails to disclose counting the packets and additionally, the terminal in Raith does not perform any of the functions explicitly recited in Applicant's claim. The elements of the claims that the Office Action asserts are performed in Raith by the terminal prior to packet transmission are received as messages by the terminal after transmission occurs. As such, Raith fails to anticipate Applicant's claims 1 and 11. Therefore, claims 1-11 are allowable.

Applicant has responded to all of the rejections and objections recited in the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Application No.: 09/805,025

Docket No.: Y0647.0139/P139

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

Dated: November 12, 2004

Respectfully submitted,

By 

Ian R. Blum

Registration No.: 42,336

DICKSTEIN SHAPIRO MORIN &
OSHINSKY LLP

1177 Avenue of the Americas

New York, New York 10036-2714

(212) 835-1400

Attorneys for Applicant

IRB/mgs